

Application No.: 09/972,582

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Docket No.: 219002028402

**REMARKS**

Claims 1, 8-10, 13, 15-20, and 23-34 are pending in this application. Claims 18-20 and 25-33 are withdrawn from consideration. Claims 1, 8-10, 13, 15-17, 23 and 24, stand rejected. Claims 1 and 16 have been amended. Claims 2-7, 11, 12, 14, 15, 18-23, and 25-33 have been cancelled. Thus, Claims 1, 8-10, 13, 16, 17, 24, and 34 are presented for prosecution. Reconsideration of the present claims is respectfully requested.

**Claims 1, 8-10, 13, 15, and 17 are fully enabled**

The Examiner has maintained the rejection of claims 1, 8-10, 13, 15, and 17 alleging that the definition of substituent L as "a divalent moiety that provides a distance of 2-8A between ring B and Ar'," is not adequately supported by an enabling disclosure for the full scope of the subject matter encompassed by the claim. Applicants respectfully disagree. Nevertheless, solely to advance the prosecution of the present case, L has been defined in those terms used in the parent case, now U.S. Patent No. 6,184,226 B1. To wit, L is  $R^1N(CH_2)_n$  and  $R^1$  is H, alkyl (1-6C) or arylalkyl optionally substituted on the aryl moiety with 1-3 substituents independently selected from the group consisting of alkyl (1-6C), halo, OR,  $NR_2$ , SR, -OOCR, -NROCR, RCO, -COOR, -CONR<sub>2</sub>,  $SO_2NR_2$ , CN,  $CF_3$ , and  $NO_2$ , wherein each R is independently H or alkyl (1-4C). Applicants submit that the present specification more than amply supports the language presently used to define L. As such, Applicants request that the present rejection of the claims be withdrawn.

**Claims 1, 8-10, 13, 15, 17, and 25-29 particularly and distinctly recite the subject matter Applicants regard as their invention**

Claims 1, 8-10, 13, 15, 17, and 25-29 stand rejected under 35 U.S.C. § 112, second paragraph, for allegedly lacking particularity and for allegedly failing to distinctly recite the subject matter Applicants regard as their invention. Applicants respectfully traverse this rejection.

The Examiner has alleged that the term "cyclic hydrocarbyl aliphatic" appearing in the definition of the substituent Ar' is indefinite. Applicants disagree. Nevertheless, to advance the prosecution of the present case, this language has been removed from the pending claims. The

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definition of the substituent Ar' no longer uses the term "cyclic hydrocarbyl aliphatic".

Claims 1, 8-10, 13, 23, and 25-32 are nonobvious over Alvi et al. because the present case is entitled to claim priority to the parent case

The Examiner has maintained the rejection of Claims 1, 8-10, 13, 23, and 25-32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Alvi, *et al.* (WO 99/18942). Applicants previously argued that Alvi *et al.* was not available as prior art because the present case claims priority to application No. 09/141,916, which was filed before the publication date of the cited reference. In the final Office Action, the Examiner rejected Applicants' position alleging that the parent application did not support the pending claims.

Without acquiescing to the Examiner's allegations, Applicants have amended the language of Claims 1 and 16 to more accurately recite the subject matter Applicants regard as their invention. Specifically, the language in Claim 1 regarding the L substituent has been amended as discussed above. Also, Claim 16 was amended to specify that Z<sup>5</sup> cannot be N. These amendments clearly bring the claimed subject matter within the disclosure of the parent case, application No. 09/141,916. As such, Applicants contend that the rejected claims are not obvious over Alvi *et al.*, because this reference is not available as prior art against the claimed invention. Accordingly, withdrawal of the present rejection is requested.

#### Terminal Disclaimer

Applicants provide with the present response copies of two terminal disclaimers which disclaim U.S. Patent Nos. 6,184,226 and 6,476,031. The terminal disclaimers were filed with the present application on October 5, 2001. Applicants submit that these terminal disclaimers were properly executed and obviate the outstanding double patenting rejection. As such, Applicants request that the present rejection be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

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In the unlikely event that the transmittal letter is separated from this request and the Patent Office determines that a fee is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952, referencing docket no. 219002028402. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: May 5, 2004

Respectfully submitted,

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